Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte MARC DAVID ABRAHAMS

Appeal No. 2004-1595
Application No. 09/618,321

ON BRIEF

Before THOMAS, BLANKENSHIP, and SAADAT, Administrative Patent Judges.

SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 1-22, which are all of the claims pending in this application.

We reverse.

BACKGROUND

Appellant's invention relates to a method of providing a product presentation to a user wherein the experience of going into a real store is simulated. According to Appellant, a three-dimensional rendering of the inside of a store appears on the

screen of the user's computer which may include products on shelves in an interactive way to give the user the ability to select certain products (specification, page 5). An understanding of the invention can be further derived from a reading of exemplary independent claim 1, which is reproduced below:

> 1. A method of providing a product presentation to a user, comprising the steps of:
>
> retrieving personalization data for a particular user from a database;
>
> assembling display data that is configured to render a three-dimensional display area on a video display, the display area including images of one or more products that are selected based on the personalization data;
>
> sending the display data through a computer network for display on a client computer video display
>
> receiving a communication from the client computer through the computer network, the communication resulting from interactions with the display area; and
>
> updating the personalization data for the particular user in the database based on the communication.

The Examiner relies on the following references in rejecting the claims:

Kaplan	5,237,157	Aug. 17, 1993
Burke	5,848,399	Dec. 8, 1998

Claims 1-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Burke and Kaplan.

We make reference to the answer (Paper No. 12, mailed February 10, 2004) for the Examiner's reasoning, and to the appeal brief[1] (Paper No. 13, filed March 10, 2004) for Appellant's arguments thereagainst.

OPINION

The focus of Appellant's arguments is that the combination of the prior art references do not disclose or suggest the claimed use of personalization data in selecting the images of the products to be displayed and instead relate to market research (brief, pages 5 & 6). Appellant specifically asserts that the portions of Burke, as relied on by the Examiner for teaching personalization data, actually describe analyzing, packaging and distributing the user profile data as timely and focused market research (brief, page 7). Additionally, Appellant argues that one skilled in the art would not be motivated to combine the references since changing Burke's display of the products using the user profile data would be contrary to its

[1] The appeal brief was refiled to include a statement regarding the grouping of the claims, which was omitted in the appeal brief filed November 21, 2003 as Paper No. 11.

purpose of displaying what a consumer would actually view in a real store (brief, page 10).

In response, the Examiner asserts that the user's personalized information is actually shown by Burke's collection of the consumer purchasing behavior and frequency (answer, page 10). The Examiner further reasons that selecting objects based on the habits of users relates to the subscriber profile in Kaplan which is the same as the claimed product selection based on personalization data (answer, pages 10 & 11).

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). The Examiner must not only identify the elements in the prior art, but also show "some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead the individual to combine the relevant teachings of the references." In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The court further reasons in Karsten Mfg. Corp. v. Cleveland Gulf Co., 242 F.3d 1376, 1385, 58 USPQ2d 1286, 1293 (Fed. Cir. 2001) that for an invention to be obvious in view of a combination of references, there must be some suggestion, motivation, or

teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in the way that would produce the claimed invention. See also In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Such evidence is required in order to establish a prima facie case. In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984).

After reviewing the applied prior art references, we disagree with the Examiner that the claimed displaying of images of products that are selected based on the "personalization data" is disclosed or suggested by the combination of Burke and Kaplan. What a reference teaches is a question of fact. In re Baird, 16 F.3d 380, 382, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994) (citing In re Beattie, 974 F.2d 1309, 1311, 24 USPQ2d 1040, 1041 (Fed. Cir. 1992)). Here, as pointed out by Appellant (brief, page 7) and based on the teachings of Kaplan (col. 3, lines 39-46) the subscriber profile data is not used for product selection for that particular user and instead, serves as information for market research. The closest Kaplan comes to suggesting any personalization data is disclosing the profile data stored in a central database which is used only for promotional and marketing activities (col. 5, lines 41-48). However, the claimed

personalization data is required to be the basis for selecting and displaying the images of the products while the user's interactions with the display area is used to update the personalization data.

We also remain unconvinced by the Examiner's argument that Burke's presentation of a store image depends on any user information. In fact, Burke uses a product database for selecting the displayed images (col. 3, lines 49-53) whereas the collected user information is stored in a research database (col. 6, lines 51-61) and used only for user behavior research instead of selecting what images to display. We note that independent claim 12 includes limitations related to displaying product images based on the stored personalization data as recited in claim 1 and discussed above. Accordingly, based on the Examiner's failure to establish a prima facie case of obviousness, the 35 U.S.C. § 103 rejection of independent claims 1 and 12, as well as claims 2-11 and 13-22, dependent thereon, cannot be sustained.

CONCLUSION

In view of the foregoing, the decision of the Examiner rejecting claims 1-22 under 35 U.S.C. § 103 is reversed.

REVERSED

JAMES D. THOMAS)
Administrative Patent Judge)
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HOWARD B. BLANKENSHIP) BOARD OF PATENT
Administrative Patent Judge) APPEALS
) AND
) INTERFERENCES
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